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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/791,027	03/02/2004	Kimberly A. Dwyer	1671-0294	1274

7590 09/22/2004  
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EXAMINER

RAMANA, ANURADHA

ART UNIT PAPER NUMBER

3732

DATE MAILED: 09/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/791,027

Applicant(s)

DWYER ET AL.

Examiner

Anu Ramana

Art Unit

3732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 3/2/2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-6, 8 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by White et al. (US 5,725,592).

White et al. disclose a modular prosthesis with a neck member 110 having a tapered post 411 and a head-receiving support member 111 to receive a head member 112, a body or "sleeve" component 120 with a tapered bore, a stem member 130 with an elongated tapered bore 431 to receive the neck member post (Fig. 4 and col. 11, lines 17-23).

White et al. also disclose an embodiment wherein the second elongated bore 114 is in the neck member and the stem member 130 has a tapered post 131 that is received in bore 114 when the components are assembled (Fig. 2, col. 6, lines 16-67, col. 7, lines 1-67 and col. 8, lines 1-12).

Claims 1 and 3-9 are rejected under 35 U.S.C. 102(e) as being anticipated by Despres, III et al. (US 6,682,568).

Despres et al. disclose a modular prosthesis including a neck member 15 with a tapered body 65, a head member 30 secured to the neck member 15, a body element or "sleeve component" 10 with a tapered bore 22 to receive tapered body 65 of neck member 15 and a stem

Art Unit: 3732

member 35 wherein the neck member has a tapered bore 80 to receive tapered post 85 of stem member 35 in an engaged fit (Fig. 1, col. 3, lines 27-67 and col. 4, lines 1-60).

### *Double Patenting*

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-2, 4-6 and 8-9 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 7 of Dwyer et al. (US 6,723,129) (Patented Claim 7 herein) in view of White et al. (US 5,725,592).

Patented claim 7 discloses all elements of the claimed invention except for (i) a sleeve component having a first elongated bore for receiving the tapered neck body of the neck member in a taper lock, and (ii) a head member.

White et al. teach a modular prosthesis system wherein a body or "sleeve" component is secured to a tapered neck body 114 of a neck member by means of an elongated bore 123 in the sleeve component, the elongated bore receiving the tapered body 114 in a taper lock (Fig. 2, col. 7, lines 62-67 and col. 8, lines 1-4). White et al. also teach a head component 112 secured to the neck component of a femoral prosthesis wherein the head component fits into a patient's pelvic socket during hip replacement surgery.

Accordingly it would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided secured the sleeve component to the neck member by providing an elongated bore in the sleeve component of Patented Claim 7, as taught by White et

Art Unit: 3732

al., for securing the sleeve component to the neck member by a taper lock. Further, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided a head component, in the device of the combination of Patented Claim 7 and White et al., during hip replacement surgery for attachment of the device to a patient's pelvic socket.

Claims 1, 3-6 and 8-9 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 17 of Dwyer et al. (US 6,723,129) (Patented Claim 17 herein) in view of White et al. (US 5,725,592).

Patented claim 17 discloses all elements of the claimed invention except for (i) a sleeve component having a first elongated bore for receiving the tapered neck body of the neck member in a taper lock, and (ii) a head member.

White et al. teach a modular prosthesis system wherein a body or "sleeve" component is secured to a tapered neck body 114 of a neck member by means of an elongated bore 123 in the sleeve component, the elongated bore receiving the tapered body 114 in a taper lock (Fig. 2, col. 7, lines 62-67 and col. 8, lines 1-4). White et al. also teach a head component 112 secured to the neck component of a femoral prosthesis wherein the head component fits into a patient's pelvic socket during hip replacement surgery.

Accordingly it would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided a sleeve component in the prosthesis of Patented Claim 17, as taught by White et al., to secure the neck member to the stem member. Further, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided a head component, in the device of the combination of Patented Claim 17 and White et al., during hip replacement surgery for attachment of the device to a patient's pelvic socket.

Claims 1-2, 4-6 and 8-9 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 2 of Dwyer et al. (US 6,706,072) (Patented Claim 2 herein) in view of White et al. (US 5,725,592).

Patented claim 2 discloses all elements of the claimed invention except for (i) a sleeve component having a first elongated bore for receiving the tapered neck body of the neck member in a taper lock, and (ii) a head member.

Art Unit: 3732

White et al. teach a modular prosthesis system wherein a body or "sleeve" component is secured to a tapered neck body 114 of a neck member by means of an elongated bore 123 in the sleeve component, the elongated bore receiving the tapered body 114 in a taper lock (Fig. 2, col. 7, lines 62-67 and col. 8, lines 1-4). White et al. also teach a head component 112 secured to the neck component of a femoral prosthesis wherein the head component fits into a patient's pelvic socket during hip replacement surgery.

Accordingly it would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided a sleeve component in the prosthesis of Patented Claim 2, as taught by White et al., to secure the neck member to the stem member. Further, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided a head component, in the device of the combination of Patented Claim 2 and White et al., during hip replacement surgery for attachment of the device to a patient's pelvic socket.

Claims 1, 3-6 and 8-9 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 8 of Dwyer et al. (US 6,706,072) (Patented Claim 8 herein) in view of White et al. (US 5,725,592).

Patented claim 8 discloses all elements of the claimed invention except for (i) a sleeve component having a first elongated bore for receiving the tapered neck body of the neck member in a taper lock, and (ii) a head member.

White et al. teach a modular prosthesis system wherein a body or "sleeve" component is secured to a tapered neck body 114 of a neck member by means of an elongated bore 123 in the sleeve component, the elongated bore receiving the tapered body 114 in a taper lock (Fig. 2, col. 7, lines 62-67 and col. 8, lines 1-4). White et al. also teach a head component 112 secured to the neck component of a femoral prosthesis wherein the head component fits into a patient's pelvic socket during hip replacement surgery.

Accordingly it would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided a sleeve component in the prosthesis of Patented Claim 8, as taught by White et al., to secure the neck member to the stem member. Further, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have

Art Unit: 3732

provided a head component, in the device of the combination of Patented Claim 8 and White et al., during hip replacement surgery for attachment of the device to a patient's pelvic socket.

### *Conclusion*

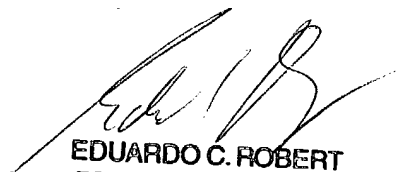
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anu Ramana whose telephone number is (703) 306-4035. The examiner can normally be reached Monday through Friday between 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver can be reached at (703) 308-2582. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AR *Anu Ramana*  
September 19, 2004

  
EDUARDO C. ROBERT  
PRIMARY EXAMINER